RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE J. ROLLINS, SAILENDRA PADALA,
NORBERT HENDRIKSE, PAUL GAUTHIER, and
MICHAEL TSO

Appeal 2007-0791
Application 09/747,666
Technology Center 3600

Oral Hearing Held: April 3, 2007

Before MURRIEL CRAWFORD, TERRY OWENS, and ROBERT NAPPI
Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came to be heard on April 3, 2007, commencing at approximately 10:05 a.m., at the United States Patent and

Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Elizabeth J. Walker, Reporter.

MR. TOERING: Good morning, Your Honors. This is Application Serial No. 09/747,666, Rollins, et al., the application entitled: "Tracking Transactions by Using Addresses in a Communications Network." And my name is Rick Toering, for appellants.

The status of the claims: 1 to 10, 18 to 27, 35 to 37 are pending in this case. All but Claims 2 and 19 are rejected under Section 102(e), as allegedly anticipated by U.S. Patent No. 6029141 to Bezos. Claims 2 and 19 stand rejected under Section 103, as allegedly unpatentable over Bezos, in view of U.S. Patent No. 6532492 to Presler-Marshall.

The appellants are appealing all the claims today, though, for purposes of today's oral argument, I would like to focus on claims 36, Claim 18, and follow-up with Claim 2. Though we would preserve all argument with regards to the other claims available to us, I just want to try and focus the issues with you today.

I would just like to talk about a brief history about the invention and the nature of the invention, how it came to be, to give some background as to the prior art and the claims.

Back in late '90s, shopping portals were a big thing, or these instances of websites referring users to other websites -- to merchants, for example. The issue was that a user would be viewing one website, and there would be a link on that page referring the user to some e-commerce website, where they could purchase a particular item.

And Amazon had this system where they were developing associate websites, and they had this associate program. And if you had a website about skiing, you could link to books about skiing that were, then, handled by Amazon, and Amazon would be glad to sell you a book, you know, when you clicked through that link.

So we have this notion occurring at this time with intermediary websites, or associate websites, or portal websites -- whatever you want to call them -- but they are generally just -- they, themselves, are not selling the goods. There is a merchant website behind them that is selling the goods.

So, in the language of our claims we use the word "intermediary." In the language of the prior art, they talk about "associates" -- "associate web pages." I want to make sure that you understand that those are sort of the same things; that the merchant website is what is behind some of the other links.

So what was happening is that, if you were an associate or an intermediate website, you would like to get a commission when a user clicked through your site to the Amazon, or the merchant, on the back side and actually bought a book. So how were they going to track this in the system?

One of the things that -- the merchants were using this to encourage these associate websites or these portal websites to actually carry their links to their products. So, when we look at it, the Bezos reference is exactly that -- it is discussing one of the early implementations of this system. They developed this notion called a referral link, and this is described in the Bezos reference.

A referral link includes a tag that identifies the intermediary website from which the user clicked to the merchant website to purchase the product. Okay. Does that make sense?

We have the link to the merchant website, and we

are tagging on this identifier, essentially, to that link, so that when its merchant receives that link and renders that page, the merchant sees this identifier, saying, "Oh, this user just came to me from the intermediary website. So if the user goes through a transaction and buys a book, I need to pay that intermediary a referral fee, or commission, or whatever it is."

So Bezos -- the reference that we have in front of us -- is this teaching of this referral link, which is, again, the link to the merchant webpage and an identifier that tags the referral source for the purposes of the merchant being able to identify from whence that click-through came.

JUDGE OWENS: Does that differ from your combined address, or does that fall outside the scope of your combined address?

MR. TOERING: No. That is combined address, okay? That is our combined address in the scope of our claims.

All right. So now what is happening? This is an early implementation -- the Bezos reference. What is happening is that everybody is tagging these click-throughs. Everybody who has a link -- every intermediary portal is tagging these click-throughs, so that they can get some referral.

The links become very large. If you look in the Bezos reference, all the links show up very nicely on one URL listing in the teachings. But what happens is that these URLs become very large. Well, at some point in time, there is a limit on the size of a URL, and that limit is, generally, 256 characters. If your URL becomes greater than 256 characters, you lose some of the information. It gets truncated, or the Internet doesn't know how to process that link, or whatever.

So our invention, then, is: What do we do when these URLs get too big? We are not trying to claim the referral links of Bezos. We are trying to claim: What happens when those referral links get too big? What do you do? Okay?

Our system is to take known portions of those referral links and generate shortened identifiers -- what we call, in the claim language, address identifiers. So you're taking a big chunk characters in that URL and replacing it with one more or more address identifiers.

For example, what we talk about in our spec, we talk about a product may have -- a product available for a merchant's website may have a very long link. You really

only need to know the link to the merchant, and you could identify a shorthand nomenclature for the actual end piece of that link to the particular product.

You know, for a company like L.L. Bean, or something, they may have thousands of products, and you could just shirt-size something or another. You could reduce that down to something with some tables, et cetera, to reduce that that link. All right? So that is our address identifiers. Those are the shortening mechanisms by which we try and reduce the size of the URL down to a manageable URL.

And that is, in essence, what we are doing. And that is, in essence, what we are trying to claim. We are trying to claim a combined address -- the referral link of Bezos. We acknowledge that those are similar devices. But when you get that combined address, you have to make a check. And our claim language of Claim 36, for example, is determining whether the combined address satisfies a particular condition, one of those conditions being -- or potentially being, in various embodiments -- the size of that URL address.

And there is a difference between Claim 36 and Claim 18, but Claim 18 talks about when this condition

is not met -- when the size is not less than a preexisting condition, the allowed size of the URL -- then we are going to make some adjustments, and Claim 18 talks about those adjustments.

The difference between Claim 18 and Claim 36 is we took out this "when" language that we were having particularly difficulty with the examiner to acknowledge. So Claim 18 has the "when" language. Claim 36 doesn't have the "when" language. It just specifies the steps that are performed.

Okay. So that, in essence, is what we are claiming. If you have a combined address, it's too big, make it smaller by generating this modified address. And the modified address included these address identifiers. That gets passed on to the merchant website.

So how does that different from Bezos? Well, we have talked a little bit about how it would be different from Bezos. We have talked about Bezos introduced this concept of a referral link, which includes the merchant's website, plus this tag. But Bezos is completely and entirely silent with regards to any checks that are performed on that referral link. There is no discussion in this reference about

checking a referral link against any condition.

JUDGE OWENS: Well, that isn't the condition the examiner is relying upon, though.

MR. TOERING: No, it's not. And I'm getting there. I'm sorry.

These referral links are hard-coded. That was one of the problems of Bezos -- they were hard-coded. If you read the Bezos reference, it talks about the referral links being hard-coded in the associates' page. Any time those things changes, they had to go back through an modify all those merchant links to encode their tags.

So what happened in the system is, as technology progressed, the intermediate websites were generating these tags automatically. They were just slapping the tags on. And that is when we started recognizing the problem that overall links were becoming too large.

All right. So we have talked about what the claim language is. We have talked about the difference that we are talking about -- that Bezos doesn't talk about, doesn't address these conditions.

And now to your point. The examiner is talking about -- throughout the prosecution, he has only referred

to the figures in his rejections. It was not until the examiner's answer that we have an articulated rejection -- you know, where his thinking is coming from.

And his thinking is that the reference teaches the claims, based on some figures, and he points to a couple figures in particular. He is looking at Figure 6 and Figure 8 of the Bezos reference.

I look at Figure 6 of the Bezos reference, and I see a skiing website with a link down here to the bottom that allows you to purchase a book. Okay? This figure itself doesn't talk about any conditions that are applied to this link or to the webpage.

And, very similarly, Figure 10 is another type of website -- Figure 10-A, as we look at it, is another type of website that, again, talks about an intermediary website with links back to a merchant. But, again, there is no check being performed on those links.

JUDGE OWENS: Well, the condition relied upon by the examiner is the ability to buy a book. It says you can't do it on this site, so it doesn't satisfy that condition.

MR. TOERING: So the condition is whether a user should buy the book.

JUDGE OWENS: Can buy the book.

MR. TOERING: Right, whether a user can buy a book. Is that a condition of the combined address, or is that a condition of the content displayed to a user at the combined address?

JUDGE OWENS: One of the advantages of being on this side of the bench is we get to ask the questions.

MR. TOERING: It was a rhetorical question. But that exactly goes to my point -- which is the examiner's rejection is based on an interpretation of this reference that goes to the user interpreting whether or not he wants to buy a book. That is the condition. That is the condition attributed to the content of the webpage, not a condition against which a combined address is measured. Okay?

We are looking at the combined address -- at the intermediary. We are not looking at the content. We are not evaluating the content. We are not determining any conditions of that content. So the examiner's reading in of that saying, "Can the user buy this book?" has no bearing on the relationship to the combined address.

And, furthermore, when you walk through the examiner's logic on this, this is the address -- this page,

Figure 6, this content -- this is the content available at the intermediary address. This is not content available at the combined address. The combined address is this little link down here on the bottom of the page.

So the examiner's attempt to say, "I'm determining whether a user can buy a book here" -- a condition -- is not being perform at the combined address. It is being performed at the intermediary address.

And this is difficult because it is a very tortured interpretation of the reference. It's hard for me to dispel that logic because it doesn't make sense. This is the combined address down here at the -- down here is the combined address, the referral link to the merchant. When you click on that, that is the link that we are evaluating. But the examiner is saying that the condition has to occur at the intermediary address. That is not applicable.

So even if you buy the ability of the examiner to evaluate content at an address for purposes of determining a condition, his construction is flawed because that condition is occurring at the intermediary address and not the combined address. When he selects the combined address, that's when you go to the merchant page, and there is no more conditions

being evaluated at that point in time, based on the rejection of the examiner.

So just to kind of elaborate on this -- or just to kind of summarize it up a little bit, our claims are not so broad as to permit this interpretation. Our claims talk about determining whether the combined address satisfies a particular condition. And the combined address is defined in the claim as a combined address that identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request.

These are the two things that are combined into a referral link. We are going to evaluate that referral link, and we are going to see if it meets a particular condition, and then we are going to go process it by reducing it, if necessary.

So, again, a fair reading of Bezos does not support the examiner's rejection.

I want to draw the distinction between Claim 36 and Claim 18 alluded to little bit earlier. We had kind of a back-and-forth with the examiner on this conditional language "when," specifying when certain steps were to be performed.

It was particularly frustrating, and I'm not

sure where that -- you know, it appears from the examiner's answer that he has withdrawn that particular aspect of his rejection. I don't know what more to say with that, other than we have asked him about it multiple times, and we still don't have a resolution, other than the answer. And we will take it as that is sufficiently on the record to say that that portion of the rejection is no longer there.

JUDGE OWENS: The examiner is relying upon the address at column 5, lines 45 to 55 of Bezos as being the combined address.

MR. TOERING: Line 5 --

JUDGE OWENS: Column 5, lines 45 to 55.

MR. TOERING: Right. That is the definition of what a URL is.

JUDGE OWENS: Right. And that is what the examiner relies upon here as the combined address.

MR. TOERING: But that's not a combined address. That is just any arbitrary URL address. If you look on page 7 of the examiner's answer, the last four or five lines of that, it says, "Specifically, when the user starts out, the user is at an associate website, which is defined by a combined address." And he provides the URL. So he is

saying that the user's associate website is defined by a combined address.

"When a user wants to order the book, the user clicks on the hyperlink, which takes the user from the intermediary website to a merchant website, thus substituting a portion or perhaps all of the intermediary's URL with the merchant's, thereby creating a modified combined address."

This is not a modified combined address. This is the referral link of Bezos.

JUDGE OWENS: It is "the" combined address.

MR. TOERING: It is "the" combined address. There is no modification. It's not fair to say that this is a modification of address. This is a complete substitution. That link is embedded in the webpage of Bezos.

JUDGE OWENS: Well, the problem the examiner had was your claim says, "substituting at least a portion of the address," and the examiner said, well, "at least" includes all.

MR. TOERING: Okay. Sure, it includes all. But there is no address identifiers, and there is -- you know, again, there is no relationship back from the modified combined address to the combined address. And there has to

be some of these relationships in here, so that the original request can be addressed.

JUDGE OWENS: Perhaps the problem is your spec says, at page 24, lines 4 to 5, "In general, an address identifier may be used to identify any aspect, characteristic, or attribute of a transaction and is not limited to the examples included herein," which include the person, company, merchant, et cetera.

MR. TOERING: Could you --

JUDGE OWENS: It's page 24, lines 4 to 5.

MR. TOERING: Oh, the address identifier, right, "can be any characteristic or attribute of a transaction and is not limited to the examples."

Well, yes, I understand that that is a broad recitation. We still don't get to the fact that a modification has occurred, because all the links in Bezos are fixed. That was one of the problems with Bezos. You had an intermediary link. The referral link is embedded in there. Where is the modification?

JUDGE OWENS: Going from one to the other, according to the examiner. If you can substitute the entire address, then --

MR. TOERING: I understand. I mean, I understand that interpretation. I don't think that is a fair reading of what Bezos discloses. I don't think that is how one of ordinary skill in the art would understand this to mean. I don't think that is even in the examining core's ability to broadly interpret the claims.

We have stepped beyond that on multiple phases here. We have stepped beyond it in terms of the condition that is being checked. We have stepped beyond it in terms of the relationships between the combined address and the modified combined address. And now you're asking to step even further when we talk about what an address identifier could mean.

I mean, to say it could mean anything could say that it could mean going from one link to another link. That is -- and this is what the examiner is saying. He is saying this is teaching mere hyperlinking. This is not teaching mere hyperlinking. Our claim dimension is not about mere hyperlinking. It's about improvements to existing hyperlinking that was occurring in the market -- a problem that was identified and a solution towards that problem.

Before we run out of time, I would like to kind of

quickly address Claim 2, which talks about -- the examiner is uncomfortable with this very broad recitation of a particular condition, which, in our reading and interpretation of the reference, is not warranted by the rejection based on this. I'm not saying the claim is not broad. I'm saying the reference being applied doesn't anticipate our claims.

But going to Claim 2, we talk about the specifics of comparing the combined address against sizes. Does it meet a size requirement? And then, does the modified combined address also meet that size requirement? So Claim 2 is bringing in, you know, one of the preferred embodiments into the claim to dispel this notion that a particular condition is some overly broad thing that we are not entitled to claim.

Claim 2 is being rejected on this reference Presler-Marshall. And where appellants and the examiner are stuck is that Presler-Marshall deals with caching systems -- caching Internet addresses, caching the content behind those Internet addresses, so that web browsing can be more efficient. If you have it local, you don't need to go get it. And if you were on a telephone line back in the day when we remember that, if you had it local, your browsing was

much faster.

Okay. The examiner is relying on a portion of Presler-Marshall, and he takes it out of context and, basically, misquotes the reference. The examiner states that, "Presler-Marshall explicitly recites candidate objects such as URLs" -- and this is in his rejection at -- or the answer at page 10, about halfway down that paragraph.

"Presler-Marshall explicitly recites candidate objects, such as URLs," and he cites a list of references in Presler-Marshall.

The first reference that he talks about -- column 3, lines 30 to 35 -- recites, "an address associated with a unit of information (a candidate object) which has been requested, such as a URL associated with a particular file." So the examiner is just reading the middle portion of that phrase, where the actual language of Presler-Marshall says, "An address and any unit of information can be a URL, if URL corresponds to address, unit of information corresponds to a particular file."

That's the fair reading of Presler-Marshall, not that a candidate object could be a URL. That is entirely inconsistent with the entirety of Presler-Marshall.

Presler-Marshall deals with these things separately. It deals with addresses, and it deals with their associated files or candidate objects entirely separately, draws distinction clearly, and only ever refers to determining the size of the candidate object -- never discusses determining the size of the addresses.

So if you were to make the combination proposed by the examiner, you would have a fair reading of Presler-Marshall. You would have address -- in our claim, a combined address, determining the condition of the combined address, would be to pull the file pointed to by that address and determining whether the size of the file exceeds some condition. We are not doing that. We are looking at the address itself. Okay? Does that make sense?

So from the straightforward point of view, the combination still fails to teach the elements recited in the claim. That's just a feature of the claim.

The next question is: Why would someone looking at Bezos be motivated to go look at Presler-Marshall? Bezos is talking about hyperlinking, and referral links, and those kinds of things. Why would he go to a system that discusses caching and determining whether the size of the cache is big

or small or whatever -- optimizing based on caching?

We fail to see how that nexus is drawn. We view the combination of these two references as improper. The Presler-Marshall is not analogous art in comparison to the e-commerce hyperlinking of Bezos.

The examiner's motivation to combine is to make things more efficient. Well, that's not a particularly helpful motivation to combine. That would render every single invention in the world, particularly in the computer area, obvious because, you know, that's what we do -- we try and make things more efficient. And that can't be a generic motivation to combine references in the manner.

Even then, our invention wouldn't work, if this combination was made -- because we are worried about the length of the URLs. We are not worried about the size of the content where those URLs point. So to make the modification proposed by the examiner, we wouldn't get to where we need to be.

The final thing on this that I would like to talk about is, throughout prosecution, the examiners have focused on the breadth of the claims. During an examiner interview that we had with Examiner Hewitt, the examiner said -- we

didn't even get a chance to really discuss the merits of the claims. The examiner said, "Your claims are too broad. I can find any reference that teaches determining, gathering, substituting -- " you know, blah. "Your claims are too broad."

When we got the advisory opinion, the little blurb in one section of the advisory says, "Features are broad enough to read on mere hyperlinking." "The features are broad enough to read on mere hyperlinking." We have already talked about that. They are not particularly broad enough to read on mere hyperlinking.

In the examiner's argument, the examiner states, "Arguments are not persuasive, as they fail to consider the breadth of the appellants' claims." I am not aware of any statute that says appellants must consider the breadth when looking at scope of patentability. If our claims are so broad, there should be no problem finding a reference that fairly discloses, teaches, or suggests the claim's invention.

JUDGE OWENS: One more question. In Claim 10, where is the concrete and tangible result?

MR. TOERING: Claim 10. The concrete and tangible result in Claim 10 has to come in interpreting the one or

more address identifiers based on a mapping between the one or more address identifiers and a portion of the combined address that is represented by the one or more addresses. So that interpretation, how that element of the claim interprets the modified combined address to get the actual combined address that is necessary to render whatever content.

JUDGE OWENS: All it requires is interpreting the address identifiers.

JUDGE NAPPI: How is that tangible?

MR. TOERING: Well, in the language of computers, interpreting means that you are looking at something and you are figuring out what -- there is a transformation that is occurring in that interpretation, so that the result of the interpreting can be used to hit the next webpage. And that is what the interpreting is.

JUDGE NAPPI: You haven't claimed any next step. You've just done the interpretation.

MR. TOERING: Okay. If it's a 101 rejection that needs to be levied against Claim 10, then a 101 rejection needs to be levied against Claim 10. And we can resolve that when prosecution is reopened.

But, at this stage, we are at appeal on bad art, in

our view, and we are trying to address the bad art. If the Board wants to open it up on a 101, you know, that's up to you, and I appreciate your insight on that.

JUDGE OWENS: Thank you.

MR. TOERING: I think I have hammered this home, and I hope that I have made our points clear. I want to make sure that, while I appreciate the opportunity to have the oral hearing to focus on some key items, I would like you to review our appeal and our reply, and we would like to maintain those arguments as well, and not be construed solely to the arguments presented here during the oral hearing. Thank you.

JUDGE OWENS: Thank you.

Whereupon, at 10:40 a.m., the hearing in the above-entitled matter was concluded.